



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,581	10/19/2001	Petrus Paulus Cornelis Avontuur	P32223	2757

20462 7590 02/13/2004

SMITHKLINE BEECHAM CORPORATION
CORPORATE INTELLECTUAL PROPERTY-US, UW2220
P. O. BOX 1539
KING OF PRUSSIA, PA 19406-0939

EXAMINER

THEISEN, MARY LYNN F

ART UNIT PAPER NUMBER

1732

DATE MAILED: 02/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/868,581

Applicant(s)

AVONTUUR ET AL.

Examiner

Mary Lynn F. Theisen

Art Unit

1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 41-81 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,41-57,59,62,64,65,67-71,74,79 and 81 is/are rejected.
- 7) ☒ Claim(s) 58,60,61,63,66,72,73,75-78 and 80 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>6</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Objections

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 41-80 have been renumbered 42-81.

Specification

2. The disclosure is objected to because of the following informalities: To agree with the drawing the following changes need to be made: Page 21 "324" should be --327--; page 21 "325" should be --328--; page 22 "4H" should be --44H--and page 22 "4L" should be --44L--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 41, 52, 53 and 70-81 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 52 and 53, the additive and/or modifier cannot be added as stated in these claims because they depend from a claim that indicates that the additive and/or modifier are added to the mixture (not the individual streams).

With respect to claims 70-81, an apparatus claim dependent upon a method claim is not acceptable form.

Claim 41 depends from cancelled claims.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 68 and 69 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 97/31691.

7. Claims 68 and 69 are rejected under 35 U.S.C. 102(a) as being anticipated by WO 98/36825.

WO 97/31691 and WO 98/36825 disclose a particulate product. Although not made by the same process as applicants, the prior art product appears to be identical to that which is claimed. The burden is upon applicants to provide evidence that the prior art products do not possess the characteristics of the claimed product. See In re Thorpe, 227 USPQ 964 (CAFC 1985).

Art Unit: 1732

8. Claims 1, 42,43,45-47,49-51,54-57,59,62,64,67-71,74,79 and 81 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 95/01221.

WO 95/01221 discloses making particles by mixing a dispersion of material in a solvent and a compressed fluid antisolvent and then adjusting the pressure so that the antisolvent is in gas form and the particles are precipitated. The mixture flows through a conduit since the area between nozzle tip 33 and tip 43 (see Fig. 3B) is considered to be a conduit. The antisolvent is carbon dioxide in a supercritical state (page 13, line 6-13). The solvent can be an alcohol (page 14, lines 5-10). A modifier can be added (page 13, lines 19-24). The particles are dried downstream (page 28, line 6-7).

9. Claims 1, 42,43,45-47,49-51,54-57,59,62,64,65,67-71,74,79 and 81 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 96/00610.

WO 96/00610 discloses the same features as WO 95/01221 above and adds the feature that the material is in an aqueous solution (applicants' claim 65).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

Art Unit: 1732

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 1, 42-49-51,54-57,59,62,64,67-71,74,79 and 81 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 95/01221.

The reference does not indicate that the pressure downstream is atmospheric or the solvent is saturated or near saturated (applicants' claims 44 and 48).

However, these requirement would have been obvious to one of ordinary skill in the art through optimization of the process since these are two of the process variables.

Allowable Subject Matter

13. Claims 58,60,61,63,66,72,73,75-78 and 80 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Lynn F. Theisen whose telephone number is 571-272-1210. The examiner can normally be reached on Thursday and Friday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on 571-272-1196. The fax phone

Art Unit: 1732

number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Mary Lynn F. Theisen
Primary Examiner
Art Unit 1732

mlt